

**REMARKS**

Applicants have amended the claims to more particularly point out their invention.<sup>1</sup> Applicants also attach an Expert Declaration demonstrating why the claim amendment does not add "new matter". Applicants also attach a Terminal Disclaimer to obviate the obviousness-type double patenting rejection. Applicants request the Examiner to reconsider and allow this patent application in view of the claim amendments and the following remarks.

**Interview Summary**

As an initial matter, applicants appreciate the time and attention that Examiner Vo devoted to the 6/19/01 personal interview. During the interview, Mr. Faris explained that applicants had filed the subject continuing application primarily in order to unequivocally establish that they are entitled to a February 22, 1995 effective filing date for the claims pending herein.<sup>2</sup>

Per the guidance given by Examiner Vo during the interview, applicants have decided to handle the continuing data/ priority claim under 35 USC §120 by amending their specification to state that this application is a "continuing" application which claims priority under 35 USC §120. As Mr. Faris explained during the interview, the subject application claims priority under 35 USC §120 from copending application Serial No. 09/001,484, now U.S. Patent No. 6,122,482, and through that application to other prior

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<sup>1</sup> Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page/s is/are captioned "version with markings to show changes made."

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applications including great-grandparent application Serial No. 08/394,234 filed 2/22/95 to which it is identical. The immediate parent application Serial No. 09/001,484 is an expanded version of Serial No. 08/394,234 that contains the disclosure of the subject specification plus additional disclosure (for example, except for reference numerals and legends, Figure 1 of the subject specification is similar if not identical to Figure 2 of immediate parent application Serial No. 09/001,484). Note that immediate parent application Serial No. 09/001,484 is a “continuation-in-part” of a “continuation-in-part” of application Serial No. 08/394,234.

As discussed during the interview, the subject specification does not add any “new matter” vis-à-vis the parent application, and it would therefore be improper to call this application a “continuation in part”. See MPEP 201.08 (“A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application ... and *adding matter not disclosed* in the said earlier nonprovisional application [citations omitted].”) On the other hand, the subject application is not identical to immediate parent application Serial No. 09/001,464. To avoid applying labels that may be misconstrued, applicants have amended their specification to change the term “continuation” to “continuing”. This amendment should remove the objection to the disclosure at page 2 of the Office Action while still perfecting applicants’ right to claim priority under 35 USC §120 back to their 2/22/1995 filing.

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<sup>2</sup> Mr. Faris explained that U.S. Patent No. 5,898,455 to Barakat et al. (of record) claims the benefit of provisional application serial no. 60/068,589 (also of record) filed 12/23/97. Applicants wish to unequivocally establish that their effective filing date predates 12/23/97.

Mr. Faris and Mr. Vo also discussed whether the subject specification adequately supports claim limitations directed to “block conversion.” Mr. Faris gave reasons why the specification does indeed provide such an adequate disclosure (e.g., the specification discloses a low-noise block converter that outputs blocks of channels received from the satellite, and the rest of the disclosed exemplary converters as well as the satellite receiver on the other end of the distribution system further process these received signal blocks).

After the interview, Mr. Faris contacted Randy Bell, an RF engineer with nearly 25 years of experience in designing various radio equipment including satellite receivers and cable television distribution systems, and asked for his opinion on this issue. Mr. Bell’s opinion, which is set forth in the attached Expert Declaration, confirms that the subject specification “provides adequate such description and would have conveyed, to an artisan ordinarily skilled in the art, that the disclosed exemplary converters are each block converters that convert blocks of multiple channels received from a satellite.” Bell Declaration at para. 2. Mr. Bell gives several reasons for his opinion, including the following:

- “[D]isclosed exemplary converters 5 and 7 each receive a block of multiple received satellite channels from the low-noise block converter 2” (para. 4);
- “[T]he ‘Description of The Preferred Embodiments’ section ... describes these converters as ‘frequency converters [which] convert the entered frequencies to frequencies which the present day amplifiers can transport’” with the “entered

frequencies” being “blocks of multiple channels outputted by the low-noise block converter 2 to the converters 5, 7.” (para. 5);

- “[T]he ‘Description of the Preferred Embodiments’ section does not say that converters 5, 7 select particular channels from the low-noise block converter output for application to cable 13” (para. 5);
- “[T]he ‘Description of The Preferred Embodiments’ section ... states that converters 22-24 and 35-37 further frequency-convert the signals from cable 13 in a ‘reverse process of the head-in processor 44’ in order to ‘reconvert the signals to the frequencies that are utilized by the source.’” (para. 6); and
- “[I]t would be readily apparent to someone skilled in the art that exemplary converters 22-24, 35-37 output blocks of multiple channels to the disclosed satellite receivers” (para. 7).

Based on Mr. Bell’s Declaration, applicants have amended their claims to add the requirement *inter alia* of “receiving, with a satellite antenna, a first block of signals having a first polarization and second block of signals having a second polarization ... [and] simultaneously communicating said frequency-converted first block of signals and said second block of signals through the cable.” Mr. Bell’s declaration makes it clear that applicant’s specification has an adequate written description for this newly added limitation. *See e.g., Vas-Cath v. Mahurkar*, 935 F.2d 1555, 1560-64 (Fed. Cir. 1991).

As discussed during the interview, this “block conversion” feature fully distinguishes the invention over the applied Uemura reference. Uemura teaches “extracting a signal of the desired channel” (see e.g. page 3 of Uemura translation and

Figure 4 and associated text). Uemura thus teaches away from a television signal distribution system that stacks frequency-converted channel blocks received from the satellite onto a cable.

### **Other Remaining Issues**

Since this application is not a continuation-in-part, there is no requirement for applicants to submit an additional inventors' declaration. See e.g., MPEP Section 201.06(c) at 200-29. In addition, Rule 63(e) was amended effective November 7, 2000 to delete the requirement that "[t]he oath or declaration in any continuation-in-part application must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application." Nevertheless, upon request and without prejudice or disclaimer, applicants are willing to voluntarily submit an executed *supplemental* declaration under Rule 67 listing the various priority applications in addition to the present amendment.

Applicants also attach a Terminal Disclaimer which obviates the "obviousness-type" double patenting rejection.

Finally, applicants have amended their specification to cure the various formal issues noted by the Examiner.

All outstanding issues have been addressed and this application is in condition for allowance. Should any minor issues remain outstanding, the Examiner should contact the

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undersigned at the telephone number listed below so they can be resolved expeditiously  
without need of a further written action.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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